



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Henry PAJAK et al.

Group Art Unit: 2155

Application No.: 09/718,477

Examiner: M. WON

Filed: November 24, 2000

Docket No.: 105730

For: METRICS AND STATUS PRESENTATION SYSTEM AND METHOD USING
PERSISTENT TEMPLATE-DRIVEN WEB OBJECTS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

After entry of the Notice of Appeal filed herewith, Applicants respectfully request review of the Final Rejection mailed August 23, 2005 and the Advisory Action mailed November 7, 2005 in the above-identified application.

I. Status of Pending Claims

Claims 1-6 and 8-25 are pending. Claims 1-6 and 8-25 are rejected. No amendments are being filed with this request.

II. Telephone Interview

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Najjar in the November 17 telephone interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

During the telephone interview, Applicants' representative discussed the November 7 Advisory Action and argued that for its withdrawal because the Advisory Action is improper and should be withdrawn. Examiner Najjar agreed. However, Examiner Najjar requested that a Pre-Appeal Brief Request be filed so that he can re-open prosecution and withdraw the Advisory Action. Accordingly, this Pre-Appeal Brief Request is filed to comply with the Examiner's request. Withdrawal of the Advisory Action and reconsideration of the Final Rejection is thus respectfully requested.

II. Issues Presented For Review

The following issues are presented for review: November 7 Advisory Action; rejection of claims 1-12 and 17-25 under 35 U.S.C. §103(a) over U.S. Patent No. 5,987,513 to Prithviraj et al. in view of U.S. Patent No. 6,529,932 to Dadiomov et al.; and rejection of claims 13-16 under 35 U.S.C. §103(a) over Prithviraj in view of Dadiomov and further in view of U.S. Patent No. 6,356,933 to Mitchell et al.

A. November 7 Advisory Action

The Advisory Action asserts that the amended claim language was not given weight in terms of patentability, because the specification allegedly fails to clearly define "wherein the at least one Web object is a self-contained entity with object data, an associated presentation and a state machine lifecycle," and allegedly does not teach "a state machine lifecycle." These assertions are respectfully traversed.

As discussed during the telephone interview, even if the amended claim language is not supported by the specification, the claim language cannot be disregarded. "When evaluating claims for obviousness under 35 U.S.C. §103(a), all the limitations of the claims must be considered and given weight, including limitations which do not find support in the specification as originally filed (i.e. new matter)." *Ex parte Grasselli*, 231 USPQ 383 (Bd.

App. 1983) *aff'd mem.* 783 F.2d 453 (Fed. Cir. 1984); see also MPEP §2143.03.

Furthermore, claims 1 and 11 were amended to include features recited in original claim 7 and originally filed claim 21 included this feature. Applicants respectfully submit that the original claims constitute a clear disclosure of the subject matter, and the claims should not be attacked either by objection or rejection because subject matter is allegedly lacking in the drawings and description. See, MPEP §608.01(I).

However, the specification clearly supports this feature. For example, the specification supports this feature at page 6, lines 5-12. Specifically, the specification states that "web objects are template-driven mechanisms that compose Web pages through the use of objects, concurrent state-machines, events and actions within states." Applicants respectfully submit that one of ordinary skill in the art would well understand this disclosure at the time of the application. Objects and state-machines were well known concepts to those skilled in the art at the time of the application. Thus, no further description would have been needed for one of ordinary skill in the art to understand the subject matter recited in the amended claim language.

Thus, as agreed the Advisory Action is improper and must be withdrawn.
Furthermore, entry and full consideration of the amendments of the October 19, 2005 Amendment After Final Rejection is proper.

B. Claims 1-7 and 8-25 would not have been rendered obvious by Prithviraj in view Dadiomov

The Advisory Action alleges the claim language "wherein the at least one Web object is a self-contained entity with object data, an associated presentation and a state machine lifecycle," was previously rejected by the teachings of Prithviraj. However, as agreed during the October 17, 2005 personal interview, Prithviraj does not disclose this feature.

Prithviraj discloses hypertext documents. See, e.g., Prithviraj, col.3 lines 35-48. However, the hypertext documents of Prithviraj are not a self-contained entity with object data, an associated presentation and a state machine lifecycle. Furthermore, the hypertext documents of Prithviraj do not process data related to the networked device, as recited in the independent claims. The network management station of Prithviraj, not the hypertext document, integrates the received data into the template and sends it back to the browser. See, e.g., Prithviraj, col. 3, lines 49-66.

Dadiomov does not remedy the deficiencies of Prithviraj. Dadiomov is only cited by the Office Action for its alleged teaching of runtime support.

Thus, because the applied reference clearly lack a feature recited in the claims, claims 1, 11 and 21, as well as the claims dependent therefrom, are patentable over Prithviraj and Dadiomov. Withdrawal of the rejection is thus respectfully requested.

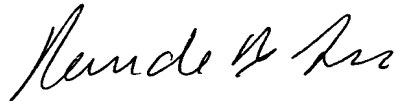
B. Claims 13-16 would not have been rendered obvious by Prithviraj in view Dadiomov and Mitchell

Dadiomov and Mitchell do not remedy the deficiencies of Prithviraj with respect to claim 11. Claims 13-16 depend from claim 11. Thus, for at least the reasons discussed above with respect to claim 11, claims 13-16 would not have been rendered obvious by Prithviraj in view of Dadiomov and Mitchell. Withdrawal of the rejection is thus respectfully requested.

III. Conclusion

For all of the reasons discussed above, it is respectfully submitted that the rejections are based upon a clear legal error and that all the pending claims are in condition for allowance. For all of the above reasons, Applicants respectfully request the panel of Examiners to review the August 23, 2005 Final Rejection and November 7, 2005 Advisory Action prior to Appeal, to vacate the Advisory Action; to enter the amendments of the October 19, 2005 Amendment After Final Rejection; and to withdraw the outstanding rejections.

Respectfully submitted,



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